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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/771,937 | 02/04/2004 | Motoharu Usumi | FUJA 20.933 (100794-00551 | 3778 |

26304 7590 04/06/2007
KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

| EXAMINER | |
|---|---|
| WORJLOH, JALATEE | |
| ART UNIT | PAPER NUMBER |
| 3621 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 04/06/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/771,937 | USUMI, MOTOHARU | |
| | Examiner | Art Unit | |
| | Jalatee Worjloh | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☒ Claim(s) *5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 1-5 have been examined.

### *Response to Amendment*

2. This Office Action is responsive to the amendment filed January 2, 2007, in which claims 15- were amended and claims 6-10 added. Claims 1-10 are pending.

### *Response to Arguments*

3. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites "judging means includes a billing judgment table for setting a billing parameter, and determines the amount of billing to be charged *to the through the user terminal*". It is unclear what is meant by "charged to the through the user terminal". Please clarify.

6. Claims 1-10 have been examined.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-4, 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 200027030 to Kei in view of US Patent No. 6199054 to Khan et al. ("Khan").

Referring to claim 1, Kei discloses a subscriber (i.e. user terminal) serving apparatus serving a user, a delivery server for delivering content (i.e. contents distribution module), a billing server for billing the delivery of the content (i.e. accounting means) (see abstract and paragraph [0008]), the subscriber serving apparatus includes monitoring means (see paragraph [0009] – in a user terminal, an information storage means accumulates the information about the receiving quality of said contents) and the billing server includes judging means (i.e. decision means). Kei does not expressly disclose judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus, and bills the user on the result of the judgment made by the judging means. Khan disclose judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream and bills the user based on the result of the judgment made by the judging means. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system of Kei to include the step of judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus, and bills the user based on the result of the judgment made by the judging means. One of ordinary skill in the art would have been motivated to do this because it eliminates the loss of

packet and data quality of streamed content that normally occurs when there is a system overload (see paragraph [0006] of Kei).

Claim 2 is rejected on the same rationale as claim 1 above.

Referring to claim 3, Kei discloses the delivery server includes means for identifying the subscriber serving apparatus serving the user terminal that originated a delivery request (see paragraph [0033] – the contents distribution module searches the contents database based on the user ID and password), and for sending information specifying the user termianl and the data stream to be monitored to the subscriber serving apparatus (see paragraph [0045]) and the subscriber serving apparatus, based on the information received from the delivery server, identifies the user terminal and the data stream to be monitored by the monitoring means (see paragraph [0046]).

Claims 4, 7 and 8 are rejected on the same rationale as claim 3 above.

As per claims 6 and 10, Kei discloses judging means (see claim 1 above). Kei does not expressly disclose the judging means judges whether to bill or not bill the user based on the delivery quality of the monitored data stream at the subscriber serving apparatus. Khan teaches calculating a cost, by the billing server, based on the quality of deliver (see claim 12). The Examiner notes that in calculating a cost of the delivery quality, the server is determining "whether to bill or not bill"; thus, this is an inherent step. Note. If it is determined that the cost is zero then the user will not be charged (i.e. "not bill") otherwise the user will be billed. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the judging means disclose by Kei to judge whether to bill or not bill the user based on the delivery quality of the monitored data stream at the subscriber serving apparatus. One of

ordinary skill in the art would have been motivated to do this because it eliminates the loss of packet and data quality of streamed content that normally occurs when there is a system overload (see paragraph [0006] of Kei).

9. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kei and Khan as applied to claim 1 above, and further in view of US Publication No. 2002/0128936 to Sako et al. ("Sako").

Referring to claim 5, Kei discloses judging means (see claim 1 above). Kei does not expressly disclose the judging means includes a billing judgment table for setting billing parameter, and determines the amount of billing to be charged to the user, based on the result of the judgment of the delivery quality of the monitored data stream and the billing. Sako discloses a billing judgment table for setting billing parameter, and determines the amount of billing to be charged to the user, based on the result of the judgment of the delivery quality of the monitored data stream and the billing (see paragraph [0041] – the quality classifications table stores billing information in order to carry out the billing in accordance with the quality of the distributed contents data). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Kei to include a billing judgment table for setting billing parameter, and determines the amount of billing to be charged to the user, based on the result of the judgment of the delivery quality of the monitored data stream and the billing. One of ordinary skill in the art would have been motivated to do this because it assist in determining the appropriate bill for the type of content quality distributed (see Sako, paragraph [0041]).

Claim 10 is rejected on the same rationale as claim 5 above.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jalatee Worjloh
Primary Examiner
Art Unit 3621

March 31, 2007